

### **REMARKS**

These remarks are responsive to the Office Action mailed on March 5, 2010 ("the Office Action"). The Applicants thank the Examiner for the examination of the above-referenced Application.

#### **Status of the Claims**

At the time of the Office Action, claims 1-54 were pending, with all claims being rejected. Claims 1, 6, 13, 19, 26, 32, 38, 44, and 52-54 are amended herein, and claims 55-58 are newly added. Support for these amendments may be found throughout the Specification and specifically in Figure 8 and in paragraphs 0015 and 0016. No new matter is being submitted.

#### **Related Applications**

In order to satisfy any potential duty that might otherwise be imposed on the Applicants or the Applicants' Attorney under the precedent set forth by the Federal Circuit in *McKesson Information Solutions v. Bridge Medical*, 487 F.3d 897, 82 U.S.P.Q.2d 1865 (Fed. Cir. 2007), the Applicants hereby notify the Examiner that this same Examiner is currently examining the following applications of the Applicants, all of which are related, and has issued Office Actions in these applications as follows:

<b>Related Application</b>	<b>Non-final Office Action</b>	<b>Final Office Action</b>	<b>Advisory Action</b>
11/327,621	Docketed New Case – Ready for Examination		
12/202,878	Docketed New Case – Ready for Examination		

The Applicants have attempted to ensure that the art cited in each of the applications listed above is also cited in any other of the application(s) listed above when

the art is relevant to the other application(s), while also attempting to ensure the IDS submissions for each of the applications listed include only the art relevant to each application.

### **Double Patenting**

The Examiner provisionally rejects claims 1-5 and 54 as allegedly being unpatentable over claims 1-4 of copending U.S. Patent App. No. 11/327,621 on the ground of nonstatutory obviousness-type double patenting. Office Action, p. 2. Since none of the conflicting claims have yet been given an indication of allowability, and since this is a provisional rejection, the Applicants respectfully request that this rejection be held in abeyance until such time as one or more of the related cases are given an indication of allowability.

### **35 U.S.C. § 112 Rejections**

Claims 1-54 currently stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Office Action, p. 3. Claims 1, 52, and 53 have been amended. It is respectfully noted that each element of the claimed implant has a proximal end and a distal end. Further the claimed implant, as a whole, has a proximal portion located approximately central to the implant and two distal portions located at opposing ends of the implant. As can be seen in the annotated Figure 15 from the present application, it is possible for a locking collar to be located at a proximal end of the housing along with the second fitting. The Applicants respectfully request that this rejection be withdrawn.

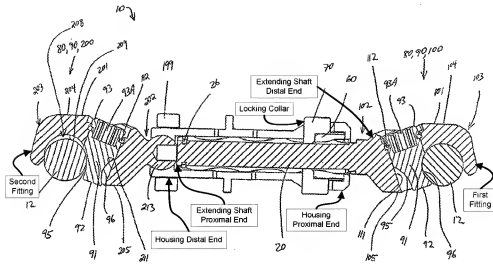
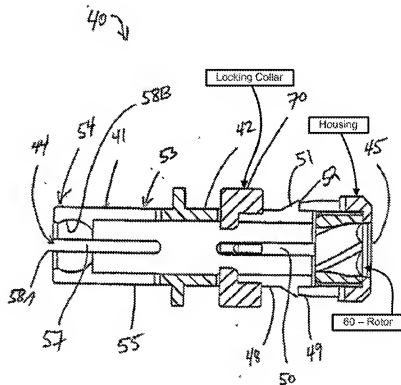


FIG. 16

### **35 U.S.C. § 102 Rejections**

Claims 1-7, 19, 20, 32, 38, 44, 50, 51, and 54 currently stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Weiste, *et al.* (U.S. Patent No. 3,837,753). Office Action, p. 4. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131. “Every element of the claimed invention must be literally present, arranged as in the claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The claims must not be treated as “mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning.” *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

The Applicants respectfully submit that the cited reference fails to anticipate a rotor axially fixed with respect to a housing, as recited by amended independent claims 1, and 52-54. As can be seen by Figure 8 of the present application, annotated below, the rotor (60) is captured within the housing such as to fix it in an axial relationship with the housing while allowing it to rotate freely within the housing.



Weiste, as interpreted by the Examiner, discloses a housing (3), a rotor (4), and a locking collar (11). Office Action, p. 4. In contrast to the limitations of the amended claims, Weiste fails to anticipate a rotor axially fixed with respect to the implant's housing. What the Examiner considers a rotor in Weiste (cylindrical part 4) is more appropriately analogous to the extending shaft in the present claim set, as Weiste's cylindrical part (4) extends with respect to the guide rod (50) just as the extending shaft

of the amended claims extends with respect to the housing of the amended claims. Further, the Examiner's analogue to a rotor (cylindrical part 4) in Weiste is axially free with respect to the Examiner's analogue to a housing (guide rod 50) in Weiste, not axially fixed with respect to the housing as amended. Under the Examiner's asserted interpretation, Weiste fails to anticipate all of the structural limitations of the independent claims of the present application.

Under another interpretation, should one consider Weiste's hollow tubular portion (3) a housing, then Weiste is left without a locking collar as defined by the amended claims. Namely, Weiste does not disclose a locking collar that has an inwardly directed protrusion engaging with an outer surface of the rotor. Under this alternative interpretation not asserted by the Examiner, Weiste still fails to anticipate all claim limitations of the independent claims of the present application.

For at least the reasons set forth herein, the Applicants respectfully submit that the cited reference fails to anticipate independent claims 1, 52, 53, and 54, and any claim depending therefrom. Thus, the Applicants respectfully request that this rejection be withdrawn.

### **35 U.S.C. § 103 Rejections**

Claims 8-13 and 21-26 currently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Weiste, *et al.*, in view of von Allwörden, *et al.* (U.S. Patent No. 4,126,057). Office Action, p. 5. In order to render a claim obvious, a combination of references must teach or suggest each and every claim limitation. The Applicants respectfully submit that the cited references, alone or combined, fail to render the present invention obvious.

As discussed above, Weiste fails to disclose a rotor that is axially fixed with respect to a housing, or alternatively, fails to disclose a locking collar. Likewise, von Allwörden fails to disclose a rotor that is fixed with respect to a housing. Like Weiste, von Allwörden discloses a rotor (inner guide 19) that is axially free with respect to a housing (outer element 1). Therefore, even when combined together, Weiste and von Allwörden fail to disclose all structural limitations of the independent claims of the present invention.

For at least the reasons set forth herein, the Applicants respectfully submit that the cited references fail to render obvious independent claims 1, 52, 53, and 54, and any claim depending therefrom. Thus, the Applicants respectfully request that this rejection be withdrawn.

#### **New Claims**

Claims 55-58 are newly added herein. They are believed to contain novel, non obvious subject matter not found in the cited references. Specifically, the cited references fail to disclose the structural limitation that translational motion of the extending shaft *causes* rotational motion of the rotor.

To make this possible, the design of the present invention has an extending shaft and rotor with mating grooves, whereby the grooves are of a very steep angle. The grooves are at such a steep angle that pushing or pulling the extending shaft in to or out of the housing causes the rotor to spin. In contrast, the cited references merely disclose what is analogous to a machine thread and a corresponding nut. It is well known that it is impossible to spin a nut simply by translational movement of its corresponding screw. An indication of allowability is respectfully requested.

**CONCLUSION**

The Applicants respectfully submit that the application is in condition for allowance, and reconsideration and notice of allowance are respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with the Applicants' counsel, in person or over the telephone, the Applicants' counsel would welcome the opportunity to do so.

Respectfully submitted,

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